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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,583	10/13/2000	Edgardo Delfino Carosella	195707USOPCT	8532

22850 7590 02/27/2003

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EXAMINER

CHUNDURU, SURYAPRABHA

ART UNIT

PAPER NUMBER

1637

DATE MAILED: 02/27/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/622,583

Applicant(s)

CAROSELLA ET AL.

Examiner

Suryaprabha Chunduru

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-13 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) 4-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3 and 16-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicants' response to the office action and amendment (Paper No. 18) filed on December 20, 2002 has been entered.

Response to Arguments

2. Applicant's response to the office action (Paper No.18) is fully considered and deemed persuasive in part.

3. The rejection made under 35 U.S.C. 112 second paragraph in the previous office action is withdrawn herein in view of the applicants' amendment (Paper No.18).

4. The following is the rejection made in the previous office action under 35 U.S.C. 102(b):

Claims 2-3 and 14-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Bensussan et al. (Proc.Natl.Acad.Sci.USA., 92: 10292-10296, 1995).

Bensussan et al. teach a method for detecting membrane-bound HLA-G expression wherein Bensussan et al. disclose that the method comprises (i) removing a tumor sample (see page 10293, column 1, lines 8-14, and table 1); (ii) performing indirect immunofluorescence on the sample (see page 10293, paragraph 4); (iii) labeling the cells of the sample with antibodies for HLA-G (see page 10293, column 1, paragraph 4 and column 2, paragraph 4). Bensussan et al. further teach lysing the labeled cells and contacting the lysed cells with HLA-G antibodies and detecting the immuno precipitates for HLA-G expression profile (see page 10294, column 1, paragraph 2). Bensussan et al. teach monoclonal antibodies of HLA-G membrane bound and soluble isoforms (see page 10294, column 1, paragraph 2); and detection of HLA-G expression (immuno precipitates) by SDS/PAGE electrophoresis (see page 10294, column 1, paragraph 2). Thus, the disclosure of Bensussan et al. meets the limitations in the instant claims.

Response to Arguments:

Applicants' arguments with respect to the rejection made under 35 U.S.C. 102(b) have been considered and are found not persuasive. Applicants amendment of claims directed to solid tumors would not overcome the rejection because the method is in the open comprising format which permits culturing solid tumor cells which was anticipated by the prior art of the record (Bensussan et al.). Bensussan et al. also uses tumor sample from a T-lymphoma patient and the tumor cells were cultured (TC9 cells) and used for analysis of HLA-G expression profile (see page 10293, column 1, lines 11-15). Applicants' amendment did not exclude the possibility of culturing the solid tumors because the amended claims comprising solid tumors would include culturing tumor cells. Therefore, the prior art of the record meets each of the limitations found in the claims. Further, the claims are of the open "comprising" format, which permits the inclusion of additional elements, so that any additional steps are permitted in the claim. Therefore the rejection is maintained herein. Amendment to include "without culturing tumor cells" would obviate the rejection.

The newly added claim 24 is also rejected as being anticipated by Bensussan et al. because Bensussan et al. teach labeling of tumor cells before lysing the tumor cells (see page 10293, column 1, paragraph 4 and column 2, paragraph 4).

Conclusion

No claims are allowable.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 703-305-1004. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and - for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Suryaprabha Chunduru
February 24, 2003


JEFFREY FREDMAN
PRIMARY EXAMINER